

March 10, 1993

*4*  
6. Cyclic isolongifolanone ketals as in claim 1, wherein R represents hydrogen and R' represents ethyl, or R represents ethyl and R' represents hydrogen. *513*

*2*  
*6062*  
*cancel* 7. Cyclic isolongifolanone ketals as in claim 1, wherein R and R' represent methyl (*a, b*).

*8.6*  
8.6 Cyclic isolongifolanone ketals as in claim 1, wherein said ketals are produced by the process comprising obtaining isolongifolene from longifolene, oxidizing isolongifolene to isolongifolene-3-one and reacting with aliphatic 1,2-dioles in an apolar solvent accompanied by separation of water.--

*END*  
REMARKS

Entry of the above, prior to consideration on the merits, is respectfully requested. Original claim 1 has been revised and separated into claims 1 and 4-7 in conformance with United States practice. Claim 2 is cancelled and presented as new claim 8.

Responsive to the telephonic restriction requirement posed by the Examiner on February 26, 1993, Applicants affirm the election of Group I, compounds, made telephonically March 2, 1993, with traverse.

Applicants traverse the restriction requirement on the grounds that the compounds of formula (A) in claim 1 are novel, and thus the use of the novel compounds as odorants is also necessarily novel.

In In re Pleuddemann, 15 USPQ2d 1738 (Fed. Cir. 1990), the Federal Circuit reviewed Durden and carefully distinguished method-

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of-use claims from method-of-making claims. A claim to a process of using a material is nonobvious and patentable if the material itself is nonobvious and patentable over the prior art, which does not include the inventor's own nonstatutory bar disclosures. Claims to methods of using materials are distinguishable from claims to methods of making materials. Under the case law, including the Durden decision, the latter but not the former may be unpatentable if the method steps are conventional in the prior art except for the novelty and non-obviousness of the specified material.

In In re Pleuddemann the inventor filed an application relating to organosilane coupling agents useful for fiberglass-filled unsaturated polyesters. The inventor disclosed the structural formula for a class of organosilane reaction products (coupling agents). When the coupling agents are used to couple or bind polyester resins to fiberglass fillers, a product with improved mechanical properties, including moisture resistance, results. Known prior art resins and fillers are used.

The inventor included the groups of claims:

- (1) the new organosilanes class;
- (2) methods of:
  - (a) bonding polymerizable material to mineral fillers; and
  - (b) priming a surface to improve its bonding to certain organic resins, both by use of the new organosilanes class; and

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(3) new articles of manufacture produced by using the new class and methods.

In response to an examiner restriction requirement, the inventor elected the first group of claims, the class of coupling agents. The United States Patent and Trademark Office allowed those claims, and the inventor obtained a patent. The inventor filed a divisional application, asserting the bonding and priming method claims. The PTO rejected the claims, reasoning that a prior art reference taught the same bonding and priming steps using different silane coupling agents. It relied primarily on In re Durden, 226 USPQ 359 (Fed. Cir. 1985), and also cited In re Kanter, 158 USPQ 331 (CCPA 1968), and In re Neugebauer, 141 USPQ 205 (CCPA 1964).

The Federal Circuit, per Judge Giles Rich, held that the PTO erred in rejecting the claims based on method-of-making cases, such as Durden. More pertinent are method-of-use cases, such as In re Kuehl, 177 USPQ 250 (CCPA 1973). The flaw in the PTO's rejection is that it presumes that the inventor's new group of compounds, which constitute an essential limitation of the claims, are prior art.

When a new and useful compound or group of compound is invented or discovered having a particular use it is often the case that what is really a single invention may be viewed legally as having three or more different aspects permitting it to be claimed in different ways, for example: (1) the compounds themselves; (2) the method of process of making the compounds[;] and (3) the method or process of using the compounds for their intended purpose. (Emphasis in original.)

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[There is] a real difference between a process of making and a process of using and the cases dealing with one involve different problems from the cases dealing with the other.

From the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing.' In re Papesch, 137 USPQ 43, 51 (CCPA 1963). It is the properties of appellant's compounds as bonding/priming agents for certain polymers and fillers or support surfaces that give them their utility ... [T]he compounds and their use are but different aspects of, or ways of looking at, the same invention and consequently that invention is capable of being claimed both as new compounds or as a new method or process of bonding/priming.

... [A] process or method of making the compounds is a quite different thing; they may have been made by a process which was new or old, obvious or nonobvious.

As to Durden:

...[It] was a case involving only the patentability of a process of making a novel insecticides and the single claim on appeal was held to be directed to obvious subject matter in view of a prior art patent disclosing a very similar process using similar reactants notwithstanding the facts that there were unobvious starting materials used and unobvious products obtained.

We are not here concerned with a process of making bonding/priming agents but with the agents themselves in which the bonding/priming properties are inherent, for which reason we do not find Durden a controlling precedent as did the examiner and the board."

As to Kuehl:

The PTO Board was aware of Kuehl and sought to distinguish it on the ground that the result of the claimed process or method should be unpredictable before nonobviousness can be found ....This involves, it seems to us, the same flaw we found in Kuehl in that it presumes appellant's new group of silane compounds to be prior art.

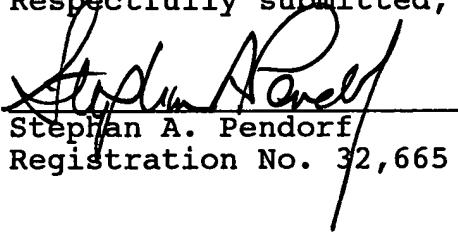
...[The] § 103 obviousness of [the bonding and priming claims] depends on the obviousness of using appellant's new compounds, which constitute the essential limitation of the claims, in light of the prior art. That being so,

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the board's hindsight comparison of the compounds of the prior art was legal error. It uses appellant's specification teaching as though it were prior art in order to make claims to methods of bonding/priming using his admittedly novel compounds appear to be obvious.

Accordingly, withdrawal of the restriction requirement is respectfully requested.

Respectfully submitted,

  
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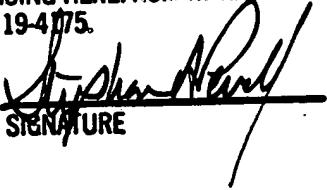
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Stephan A. Pendorf

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